

REMARKS

Claims 22-24 stand rejected under 35 USC 103(a) as being obvious over WO 00/65140 to Matsunaga et al. Claims 22-24 stand rejected under 35 USC 102(b) as being anticipated by, or in the alternative, under 35 USC 103(a) as being obvious over US2003/0152743 to Matsunaga et al. Note, as the Examiner indicates, US2003/0152743 is equivalent to WO/65140, accordingly, these two applications will be collectively referred to as "Matsunaga" herein.

Applicants claim "A carpet comprising a carpet pile comprising an aliphatic polyester multifilament crimped yarn obtained by drawing a non-drawn yarn comprising a polylactic acid via two-step drawing process, in which the yarn is drawn to 1.01-3 times in the first step and to 1.01-3 times in the second step." The cited prior art fails to disclose a yarn prepared utilizing the claimed two-step process. In the pending action, the Examiner states:

As previously argued, applicant's own working examples presented in the specification show that a one-step process can be employed produce yams possessing like properties. This conflicting evidence suggests that there are other factors dependent upon producing the claimed yam properties other than merely recited two-step process. While the data of said Declaration is not disputed, it does not establish significant differences are obtained by one process over another. In other words, a change in a process variable is expected to produce a slight change in the product. However, it is not clear said process should be given patentable weight, since the specification evidences said difference in properties is not necessarily due to the difference in said process variable. Once again, note Example 12 and Comparative Example 3, which produce yarns having properties similar to those claimed by a one-step process like that disclosed in the prior art. Therefore, applicant's arguments are found unpersuasive and the above rejections stand.

Action dated April 26, 2010, pages 4 and 5.

As stated in MPEP section 2112 "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" (quoting *In re Robertson*, 169 F.3d 743, 745, 49

USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)). In the pending action, the Examiner argues that it may be possible to achieve the claimed crimped yarn using a one-step drawing process. As provided above, a rejection based on inherency cannot be based on “probabilities or possibilities.”

In addition, the specification actually makes clear that the claimed two-step drawing process affects the final product. As described in paragraph [0089] of the specification, the “two-step drawing process provides the aliphatic polyester multifilament crimped yarn having stable quality while being available of being drawn at higher drawing scale. Crimping the aliphatic polyester multifilament crimped yarn drawn at a higher scale provides a state of high orientation and high crystallinity.”

The Examiner cites to Example 12 as allegedly supporting the conclusion that a one-step drawing process can be used to produce the same yarn as a two-step drawing process. This is incorrect. Example 12 was produced utilizing a one-step drawing process instead of the two-step drawing process of Example 1. As shown in Table 1, Example 12 had inferior breaking ability, spinning ability, tufting ability and compression resistance as compared to Example 1. This proves that the claimed two-step drawing process produces a yarn with different physical characteristics as the one-step drawing process. In addition, the Examiner’s reliance on Comparative Example 3 is misplaced since Comparative Example 3 utilized polyethylene terephthalate not polylactic acid (PLA) yarns as claimed. Accordingly, the physical characteristics of Comparative Example 3 are completely different from the claimed yarns.

Since the prior art does not disclose or suggest a PLA yarn produced with the claimed two-step drawing process and since these characteristics are not inherent to yarns produced with a one-step drawing process, the rejections of claims 22-24 should be withdrawn.

In view of the above, each of the claims in this application is in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the

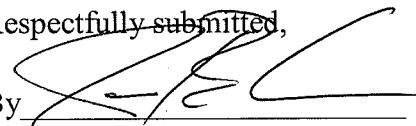
claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing **Docket No.**

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